

R E M A R K S

Careful review and examination of the subject application are noted and appreciated.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

The rejection of claims 34-41, 45-50, 52, 54-59, 61-63, 66, 69-75, 77-84, 88-93, 95, 97-102, 104-106, 108, 109 and 112-118 under 35 U.S.C. §103 as being unpatentable over Fu et al. (U.S. Patent No. 4,803,625; hereinafter Fu) and Lee (U.S. Patent No. 4,838,275) in view of Kirk et al. (U.S. Patent No. 5,390,238; hereinafter Kirk) is respectfully traversed and should be withdrawn.

The rejection of claims 42, 44, 85 and 87 under 35 U.S.C. §103 as being unpatentable over Fu, Lee and Kirk and further in view of Beckers (U.S. Patent No. 5,019,974) is respectfully traversed and should be withdrawn.

The rejection of claims 51, 53, 60, 64, 67, 68, 94,96, 103, 107, 110 and 111 under 35 U.S.C. §103 as being unpatentable over Fu, Lee and Kirk and further in view of Fujimoto (U.S. Patent No. 5,339,821) is respectfully traversed and should be withdrawn.

The rejection of claims 43 and 86 under 35 U.S.C. §103 as being unpatentable over Fu, Lee and Kirk, and further in view of Examiner's use of Official Notice is respectfully traversed and should be withdrawn.

The rejection of claims 76 and 119-138 under 35 U.S.C. §103 as being unpatentable over Fu, Lee and Kirk, and further in view of Examiner's use of Official Notice is respectfully traversed and should be withdrawn.

An Applicant may overcome a 35 U.S.C. §103 rejection based on a combination of references by showing completion of the invention by the Applicant prior to the effective date of any of the references (MPEP §715.02(I)). The Applicant need not antedate the reference with the earliest filing date (MPEP §715.02(I)). The Applicant may antedate a reference by providing evidence of prior conception of the invention coupled with reasonable diligence beginning prior to the effective reference date until either an actual reduction to practice of the invention or the filing of the patent application (see 37 CFR 1.131(b)). Proof of reasonable diligence does not require the inventor to work constantly on the invention or to drop all other work (*Mycogen Plant Science, Inc., v. Monsanto Co.*, 252 F.3d 1306, 1316, 58 USPQ2d 1891, 1899 (Fed. Cir. 2001), reh'g denied, 261 F.3d 1345, 59 USPQ2d 1852 (Fed. Cir. 2001); see *Bey v. Kollonitsch*, 806 F.2d 1024, 1028, 231 USPQ 967, 970 (Fed. Cir. 1986)).

The earliest priority date of Kirk is June 15, 1992. In particular, Kirk has a filing date of June 15, 1992 (see Kirk at page 1, item (22)). The present invention was conceived prior to June 15, 1992 (see paragraph 5 of the Declaration of Stephen J.

Brown). Therefore, the earliest effective filing date of Kirk is after the conception of the present invention.

Contrary to the position taken in the Office Action (see page 3, section 8 of the Office Action), Applicant has provided specific evidence that he worked reasonably diligently from prior to June 15, 1992 until November 17, 1992, the effective filing date of the present application. In particular, the Declaration of Stephen J. Brown and the associated Exhibits A-AB, which were filed on September 19, 2006, provide specific evidence of reasonable diligence from just prior to the filing date of Kirk (i.e., June 15, 1992) up to the effective filing date of the present application (i.e., November 17, 1992). The presently claimed invention was conceived prior to the effective date of Kirk and diligently reduced to practice through the filing of the patent application to which the present application claims priority (see the Declaration of Stephen J. Brown). Therefore, Kirk is not available as prior art against the claims. As such, the presently pending claims are fully patentable over the cited references and the rejections should be withdrawn.

The Office Action cites the MPEP as stating "The work relied upon to show reasonable diligence must be directly related to the reduction to practice of the invention in issue" (see page 4, lines 14-17, of the Office Action citing MPEP §2138.06). The declaration submitted clearly identifies how the work evidenced by

the associated exhibits is directly related to the development of technology for the presently claimed invention. For example, paragraph 2 of the declaration identified how work evidenced by the attached Exhibits was related to development of the elements of the presently claimed invention. Paragraphs 14, 15, 18, 19 and 21-28 also identify exhibits providing evidence of ongoing work related to the present invention.

The Office Action further cites the MPEP as stating that "The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses" (see page 4, lines 6-13, of the Office Action citing MPEP §2138.06). The declaration submitted clearly identifies affirmative acts and acceptable excuses. For example, paragraph 10 of the declaration states:

During the period from March 2, 1992 to November 17, 1992, I was either diligently working on the present invention, or performing my other duties as CEO of the company. The time line has been detailed with various documents attached as Exhibits C to AB, which are described below.

Paragraphs 11-32 and 35-46 and the referenced exhibits account for affirmative acts taken in furtherance of the present invention or related to Applicant's duties as CEO. Proof of reasonable diligence does not require the inventor to work constantly on the invention or to drop all other work (*Mycogen Plant Science, Inc., v. Monsanto Co.*, 252 F.3d 1306, 1316, 58 USPQ2d 1891, 1899 (Fed.

Cir. 2001), reh'g denied, 261 F.3d 1345, 59 USPQ2d 1852 (Fed. Cir. 2001); see *Bey v. Kollonitsch*, 806 F.2d 1024, 1028, 231 USPQ 967, 970 (Fed. Cir. 1986)).

The Office Action further cites the MPEP as stating that "An applicant must account for the entire period during which diligence is required (citing *Gould v. Schawlow*)" and "Diligence requires that applicant must be specific as to dates and facts" (see page 4, lines 1-5, of the Office Action citing MPEP §2138.06). The declaration submitted clearly identifies work accounting for the entire period from prior to the filing date of Kirk (i.e., June 15, 1992) up to the effective filing date of the present application (i.e., November 17, 1992). Furthermore, the declaration and exhibits are specific with regard to dates and facts. Therefore, the Applicant has accounted for the entire period during which reasonable diligence is required.

Furthermore, the Office Action's statement that the exhibits describe only a patient interface system but have no integration of the overall system including a physician interface until Exhibit T dated August 13, 1992, does not appear to recognize that the efforts taken by the Applicant need not be the most expeditious but rather it is enough that the efforts taken lead to a reduction to practice (see MPEP §2138.06 citing *Justus v. Appenzeller*). Specifically, MPEP §2138.06 states:

Although it is possible that patentee could have reduced the invention to practice in a

shorter time by relying on stock items rather than by designing a particular piece of hardware, patentee exercised reasonable diligence to secure the required hardware to actually reduce the invention to practice. "[I]n deciding the question of diligence it is immaterial that the inventor may not have taken the expeditions course...." (citing *Justus v. Appenzeller*, 177 USPQ 332, 340-1 (Bd. Pat. Inter. 1971)).

In the case of the present invention as in the case of *Justus*, it is immaterial to the question of reasonable diligence that the exhibits have no integration of the overall system including a physician interface until Exhibit T dated August 13, 1992.

Furthermore, the declaration sets forth facts to support that the efforts made were part of an overall scheme of inventive activity directed toward reducing the invention to practice. In *In re Jolley*, 308 F.3d 1317, 64 USPQ2d 1901 (Fed. Cir. 2002), the Federal Circuit found that the PTO Board did not err in determining that it was reasonable for a party to test a simpler composition (e.g., X and Z) as a step toward reducing a more complex composition (e.g., X+Y+Z) to practice. Here as in *Jolley*, the Applicant's efforts on individual parts of the claimed invention prior to the integration of the individual parts is reasonable and therefore supports that Applicant was reasonably diligent from prior to the filing date of *Kirk* (i.e., June 15, 1992) up to the effective filing date of the present application (i.e., November 17, 1992).

Furthermore, the conclusion by the Office that "the Applicant has failed to provide evidence with respect to works directly related to the reduction to practice of the invention and providing an acceptable excuse for the time lapse between months showing reasonable due diligence" (see last line on page 4 through line 3 on page 5 of the Office Action) again appears to indicate that the proper standard for reasonable diligence has not been applied. In particular, MPEP §2138.06 states:

The diligence of 35 U.S.C. 102(g) relates to reasonable "attorney-diligence" and "engineering-diligence" which does not require that "an inventor or his attorney drop all other work and concentrate on the particular invention involved" (MPEP §2138.06 citing *Keizer v. Bradley*, 270 F.2d 396, 397, 123 USPQ 215, 216 (CCPA 1959) and *Emery v. Rondan*, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974)).

The fact that the Applicant need not drop everything and work only on the invention is further evidenced by the Federal Circuit's decision in *Monsanto Co. v. Mycogen Plant Science, Inc.*, 261 F.3d 1356, 59 USPQ2d 1930 (Fed. Cir. 2001); hereinafter *Monsanto*. In *Monsanto*, the Court stated:

The law regarding diligence is settled.

However, there need not necessarily be evidence of activity on every single day if a satisfactory explanation is evidenced. Proof of reasonable diligence, however, does not require a party to work constantly on the invention or to drop all other work [citing *Mycogen Plant Science, Inc. v. Monsanto Co.*,

The declaration submitted clearly provided satisfactory explanations to excuse any requirement for evidence of activity on every single day. Specifically, paragraph 10 of the declaration states:

During the period from March 2, 1992 to November 17, 1992, I was either diligently working on the present invention, or performing my other duties as CEO of the company. The time line has been detailed with various documents attached as Exhibits C to AB, which are described below.

Paragraph 11 of the declaration states:

My duties as CEO included preparing applications for grants, which directly contributed to financing needed to develop and produce products related to the present invention, traveling, attending conferences, as well as other items related to the day to day running of the company. As is common for most CEOs, I worked hours far in excess of the normal 40 hour week.

Paragraphs 11-32 and 35-46 and the referenced exhibits account for affirmative acts taken in furtherance of the present invention or related to Applicant's duties as CEO. Paragraphs 33 and 34 account for time when Applicant was with his family. Paragraph 29 and Exhibit Q provide evidence of the employment of an individual during the period from June 1992 to December 1992 whose work included development of the present invention. Thus, Applicant has submitted evidence providing satisfactory explanations to excuse

any requirement for proof that activity took place on every single day.

Furthermore, in *Monsanto* the Court cited *Jones v. Evans*, 46 F.2d 197, 202, 8 USPQ 240, 245 (1931) as finding diligence despite a possible interval from April 16 to early in July in which it did not affirmatively appear that any steps were being taken, but during which some activity was ongoing. The declaration and associated exhibits clearly evidence that activity on the present invention was ongoing during the period from prior to the filing date of Kirk (i.e., June 15, 1992) up to the effective filing date of the present application (i.e., November 17, 1992). Furthermore, the full time employment of Jack Thornton as Director of Product Development during the period from June 1992 through December 1992 and the fact that his job included working on the specifications for the present invention (see paragraph 20 of the Declaration and Exhibit Q) provide evidence that activity on the present invention was ongoing during the period from prior to the filing date of Kirk (i.e., June 15, 1992) up to the effective filing date of the present application (i.e., November 17, 1992). Therefore, here, as in *Jones v. Evans*, the declaration and associated exhibits support that Applicant was reasonably diligent from prior to the filing date of Kirk (i.e., June 15, 1992) up to the effective filing date of the present application (i.e., November 17, 1992). As such, the rejections do not appear to be sustainable and should be withdrawn.

Accordingly, the present application is in condition for allowance. Early and favorable action by the Examiner is respectfully solicited.

The Examiner is respectfully invited to call the Applicants' representative at 586-498-0670 should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge Deposit Account No. 50-0541.

Respectfully submitted,

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